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EXAMINER
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PORTER, RACHEL L

ART UNIT	PAPER NUMBER
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3626

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02/04/2013

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/748,359	<b>Applicant(s)</b> LENCKI ET AL.	
	<b>Examiner</b> RACHEL L. PORTER	<b>Art Unit</b> 3626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2012.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 5) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 1-4,6-12,14-21,25-31,33-40,42-48,50,51,70-73,75-79,81,82,106 and 108-110 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

\* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see [http://www.uspto.gov/patents/init\\_events/pph/index.jsp](http://www.uspto.gov/patents/init_events/pph/index.jsp) or send an inquiry to [PPHfeedback@uspto.gov](mailto:PPHfeedback@uspto.gov).

### Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 3) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 4) <input type="checkbox"/> Other: ____.  |

Continuation of Disposition of Claims: Claims pending in the application are 1-4,6-12,14-21,25-31,33-40,42-48,50,51,70-73,75-79,81,82,106 and 108-110.

### **DETAILED ACTION**

1. This communication is in response to the amendment filed 9/12/2012. Claims 1, 6-12, 14-21, 25-31, 33-40, 42-48, 50-51, 70-73, 75-79, 81-82, 106, and 108-110 are pending. Claims 2-4 have been cancelled.
2. A previous request for continued examination under 37 CFR 1.114 was filed in this application on 2/17/11, after a decision by the Board of Patent Appeals and Interferences, rendered 9/1/10.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of 35 U.S.C. 112(a):

(a) IN GENERAL.—The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

The following is a quotation of 35 U.S.C. 112 (pre-AIA), first paragraph:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 21, 25-31, 33-39, 70, 75-79, 81-82, 108 and 110 are rejected under 35 U.S.C. 112(a) or 35 U.S.C. 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor or a joint inventor, or for pre-AIA the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 21, 70,108 and 110 have been amended to recite "the benefit categories each being a subset of the benefit type." The Examiner was unable to locate and the Applicant did not cite support for this newly added limitation. While the specification discloses the terms "benefit type" and "benefit category(-ies)," there is no description of a hierarchical or nested relationship between the type and category.

On the contrary, the terms appear to be used interchangeably in sections of the specification. For example on pg. 55, lines 5-8 discloses: "The user is prompted to select 2008 the benefit he or she wishes to configure, and may be taken 2009 to a separate section to configure certain benefit types (e.g. future benefit types, such as life insurance and 401(K))." Furthermore, on pg. 91, lines 5-6, the specification discloses: "Group benefit contribution 2122 may comprise employer group pre- and post-tax contribution at the benefit type level (e.g. health insurance and life insurance)..." Meanwhile the summary of the invention discloses: "The invention is applicable to a wide range of benefit categories, including, but not limited insurance benefits such as health insurance." (pg. 3, line 17-18). (Originally filed claims 3-4 further recite "[a] method according to claim 1, wherein said benefit category comprises insurance benefits" and claim 4: "[a] method according to claim 3, wherein said insurance benefits comprise health insurance benefits." Throughout the specification, it is indicated that examples of a benefit type or a benefit category both include health insurance or life insurance (among other benefits).

Claims 25-31, 33-39, 75-79, 81-82, inherit the deficiencies of their respective independent claims, and are therefore also rejected.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 21, 25-31, 34-36, 39, 70, 75-79, 82 and 108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wizig (USPN 6,735,569) in view of Warady et al. (US 6067522)

[claim 21] Wizig discloses a method of providing healthcare to an employee comprising:

- receiving an insurance coverage package selection from the employee wherein the insurance coverage package corresponds to a benefit type and automatically includes coverage under a plurality of benefit categories associated with the benefit type (e.g. insurance—benefit type); (Figure 55; col. 14, lines 38-64)
- for each of the plurality of benefit categories automatically included in the package, receiving via the user interface a purchase selection from the employee corresponding to one of the plurality of different line items associated with the benefit category; and (Fig. 30, 33; col. 14, lines 38-64; Figure 55)
- providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in accordance with the purchase selections made by the employee (Col. 16, lines 47-col. 17, line 39)

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Wizig discloses a method for customizing insurance coverage, as explained, but does not expressly disclose:

- displaying a plurality of different line items associated with the benefit category to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero.

Warady discloses

- simultaneously displaying a plurality of different line items associated with the benefit category (e.g. medical: Description of options A-M) to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category (out of pocket cost— e.g. deductible) and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category (cost for employee only, employee+children; employee+spouse; employee+spouse) and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero (Fig. 7A-B).

At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Wizig with the teaching of Warady to provide users with information on out-of-pocket costs as they are selecting a personalized healthcare plan. As suggested by Warady, one would have been motivated to include this feature to ensure that the employee is informed of and can easily enroll in the various plan options that match their needs. (col. 9, lines 49-col. 10, line 8)

Claim 21 has been amended to recite: "the benefit categories each being a subset of the benefit type..." (See rejection under 35 USC 112, 1<sup>st</sup> para.), and "the line items each being a subset of the benefit category."

Wizig discloses providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in accordance with the purchase selections made by the employee (Col. 16, lines 47-col. 17, line 39) (reads on benefit categories each being a subset of the benefit type)

Regarding the limitation of "the line items each being a subset of the benefit category" Warady discloses "simultaneously displaying a plurality of different line items associated with the benefit category (e.g. medical: Description of options A-M) to the employee on a user interface" (Fig. 7A-B).

Claim 21 has been further amended to recite: "identifying on said interface a predefined contribution, provided to said employee by an employer of said employee, for purchases associated with at least one of (i) the benefit type and (ii) at least one of the plurality of benefit categories" Wizig discloses identifying on a user interface a

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predefined contribution provided to said employee by an employer of said employee, for purchases *associated with at least one of* (i) the benefit type and (ii) at least one of the plurality of benefit categories. (Figure 24, 30, 53; Col. 12, lines 24-35: *An example of an employer confirmation page for the user "John Michael Jones", whose employer Wizig & Company contributes \$5,000.00 per year to his healthcare services package, is illustrated in FIG. 24.* Figure 54, col. 25, lines 5-12: *Generally, the sponsor report selection form allows the sponsor 130 to select a customized report based on either its plan members (e.g., by geographic area) or its aggregated or detailed contribution amounts (e.g., by month). The sponsor's report selection is received in step 844-* It should be noted any contribution of the employer for benefits is associated with at least one of: a benefit type or the plurality of benefit categories)

Wizig discloses a method wherein at least one of the different line items displayed on the interface includes a predefined employer contribution to said employee for purchase of said at least one of said line items. (col. 12, lines 24-29; Figure 30, 53), wherein said employee's employer provides said predefined contribution. (col. 12, lines 24-29; Figure 24)

Furthermore, it should be noted that these limitations regarding the data that are displayed on the screen, are nonfunctional description material and are not functionally involved in the steps recited. In particular, the steps recited in the claim would be performed the same regardless of the data contents of the noted material (i.e. the data displayed on the screen, simultaneously or otherwise). Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See

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*In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

[claims 25-26] Wizig teaches a method wherein said wherein said benefit costs to the employee for purchasing the coverage under the benefit category are established based on prior cost data or actuarial data. (col. 9, lines 50-67; col. 16, lines 47-col. 17, line 23; col. 20, lines 54-col. 21, line 50)

[claim 27] Wizig teaches a method further comprising: identifying a plurality of options for purchase by said employee within said line items. (Fig. 33)

[claim 28] Wizig teaches a method wherein said options comprise cost sharing options. (col. 8, lines 59-col. 9, line 19; Figure 33: sponsoring and co-payment)

[claim 29] Wizig teaches a method according to claim 27, wherein said options comprise place of service options. (Figure 28: e.g. distance in miles/time from providers)

[claim 30] Wizig teaches a method wherein options comprise benefit provider network options. (col. 13, lines 30-51; col. 15, lines 43-57)

[claim 31] Wizig teaches a method further comprising: identifying a plurality of sub-options for purchase by said employee within said options. (Figures 30-31,55; col. 14, lines 38-64)

[claim 34] Wizig teaches method wherein said computer network is a global computer network and wherein said user interface is provided at a web site on said network. (col. 6, lines 1-24)

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[claim 35]      Wzig teaches a method further comprising: identifying factors on said user interface for said employee to consider in connection with the purchase of one or more of said line items. (Figures 26-29)

[claim 36]      Wzig teaches a method further comprising: querying said employee through said user interface for personal information related to said employee Figure 20; Figure 28 e.g. preferences); and explaining the need for said personal information on said user interface. (Figure 28—explains how preference information is used)

[claim 39]      Wzig teaches a method further comprising:

- storing data comprising personal information related to said employee and representing each said line item purchased by said employee; and (col. 10, lines 66-col. 11, line 8, lines 14-31; Figures 4A-4D, col. 13, lines 18-col. 14, line 25)
- transmitting said data to a customer service vendor configured to automatically build a customer benefit summary for said employee based on said data. (Figure 33, 55; col. 14, lines 38-64—e.g. Express Buy)

[claim 70]      Wzig teaches a system for providing benefits to an employee comprising:

- at least one database; (col. 7, line 47-56; Figures 1- 2)
- at least one processor for accessing said database; (Figs. 1-2; col. 6, line 62-col. 7, line 46) and
- a user-interface accessible through a computer network (col. 6, lines 15-24) for accessing said processor (Figures 1-2; 30-31; col. 6, lines 4-34)

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- wherein the at least one processor receives an insurance coverage package selection from the employee wherein the insurance coverage package corresponds to a benefit type and automatically includes coverage under a plurality of benefit categories associated with the benefit type (e.g. insurance—benefit type); (Figure 55; col. 14, lines 38-64)
- wherein for each of the plurality of benefit categories automatically included in the package, the at least one processor receives via the user interface a purchase selection from the employee corresponding to one of the plurality of different line items associated with the benefit category; and (Fig. 30, 33; col. 14, lines 38-64; Figure 55)
- wherein the at least one processor is used for providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in accordance with the purchase selections made by the employee (Col. 16, lines 47-col. 17, line 39)

Wizig discloses a method for customizing insurance coverage, as explained, but does not expressly disclose:

- displaying a plurality of different line items associated with the benefit category to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category and wherein

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the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero.

Warady discloses:

- simultaneously displaying a plurality of different line items associated with the benefit category (e.g. medical: Description of options A-M) to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category (out of pocket cost— e.g. deductible) and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category (cost for employee only, employee+children; employee+spouse; employee+spouse) and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero (Fig. 7A-B).

At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Wizig with the teaching of Warady to provide users with information on out-of-pocket costs as they are selecting a personalized healthcare plan. As suggested by Warady, one would have been motivated to include this feature to ensure that the employee is informed of and can easily enroll in the various plan options that match their needs. (col. 9, lines 49-col. 10, line 8)

Claim 70 has been amended to recite: “the benefit categories each being a subset of the benefit type...” (See rejection under 35 USC 112, 1<sup>st</sup> para.), and “the line items each being a subset of the benefit category.”

Wizig discloses providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in accordance with the purchase selections made by the employee (Col. 16, lines 47-col. 17, line 39) (reads on benefit categories each being a subset of the benefit type)

Regarding the limitation of “the line items each being a subset of the benefit category” Warady discloses “simultaneously displaying a plurality of different line items associated with the benefit category (e.g. medical: Description of options A-M) to the employee on a user interface” (Fig. 7A-B).

Claim 70 has been further amended to recite: “identifying on said interface a predefined contribution, provided to said employee by an employer of said employee, for purchases associated with at least one of (i) the benefit type and (ii) at least one of the plurality of benefit categories” Wizig discloses identifying on a user interface a predefined contribution provided to said employee by an employer of said employee, for purchases *associated with at least one of* (i) the benefit type and (ii) at least one of the plurality of benefit categories. (Figure 24, 30, 53; Col. 12, lines 24-35: *An example of an employer confirmation page for the user "John Michael Jones", whose employer Wizig & Company contributes \$5,000.00 per year to his healthcare services package, is illustrated in FIG. 24.* Figure 54, col. 25, lines 5-12: *Generally, the sponsor report selection form allows the sponsor 130 to select a customized report based on either its*

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*plan members (e.g., by geographic area) or its aggregated or detailed contribution amounts (e.g., by month). The sponsor's report selection is received in step 844- It should be noted any contribution of the employer for benefits is associated with at least one of: a benefit type or the plurality of benefit categories)*

Wizig discloses a method wherein at least one of the different line items displayed on the interface includes a predefined employer contribution to said employee for purchase of said at least one of said line items. (col. 12, lines 24-29; Figure 30, 53), wherein said employee's employer provides said predefined contribution. (col. 12, lines 24-29; Figure 24)

Furthermore, it should be noted that these limitations regarding the data that are displayed on the screen, are nonfunctional description material and are not functionally involved in the steps recited and do not structurally alter the hardware used to perform the recited function. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

[claim 75] Wizig teaches a system wherein said database further comprises data representing a plurality of options for purchase by said employee within said line items. (Fig. 33)

[claim 76] Wizig teaches a system wherein said options comprise cost sharing options. (col. 8, lines 59-col. 9, line 19; Figure 33: sponsoring and co-payment)

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[claim 77] Wizig teaches a system wherein said options comprise place of service options. (Figure 28: e.g. distance in miles/time from providers)

[claim 78] Wizig teaches a system wherein said options comprise benefit provider network options. (col. 13, lines 30-51; col. 15, lines 43-57)

[claim 79] Wizig teaches a system wherein said at least one database further comprises data representing a plurality of sub-options for purchase by said employee within said options. (Fig. 13)

[claim 82] Wizig teaches a system wherein said computer network is a global computer network and wherein said user interface is provided at a web site on said network. (col. 6, lines 1-24)

[claim 108] Wizig teaches a method of establishing a health care benefits offering to an employee group comprising:

- establishing a healthcare cost for said group; (Figures 4A-D, 32, col. 16, lines 19-47, e.g. family plans) and
- establishing a plurality of health care line different items based on said cost. (Figures 31-32, col. 16, lines 19-47)
- receiving an insurance coverage package selection from an employee in the group wherein the insurance coverage package corresponds to a benefit type and automatically includes coverage under a plurality of benefit categories associated with the benefit type (e.g. insurance—benefit type); (Figures 25, 37-38; 55; col. 14, lines 38-64)

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- for each of the plurality of benefit categories automatically included in the package, receiving via the user interface a purchase selection from the employee corresponding to one of the plurality of different line items associated with the benefit category; and (Fig. 30, 33; col. 14, lines 38-64; Figure 55)
- providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in accordance with the purchase selections made by the employee (Col. 16, lines 47-col. 17, line 39)

Wizig discloses a method for customizing insurance coverage, as explained, but does not expressly disclose:

- displaying a plurality of different line items associated with the benefit category to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero.

Warady discloses:

- simultaneously displaying a plurality of different line items associated with the benefit category (e.g. medical: Description of options A-M) to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that

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corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category (out of pocket cost— e.g. deductible) and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category (cost for employee only, employee+children; employee+spouse; employee+spouse) and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero (Fig. 7A-B).

At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Wizig with the teaching of Warady to provide users with information on out-of-pocket costs as they are selecting a personalized healthcare plan. As suggested by Warady, one would have been motivated to include this feature to ensure that the employee is informed of and can easily enroll in the various plan options that match their needs. (col. 9, lines 49-col. 10, line 8)

Claim 108 has been amended to recite: "the benefit categories each being a subset of the benefit type..." (See rejection under 35 USC 112, 1<sup>st</sup> para.), and "the line items each being a subset of the benefit category."

Wizig discloses providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in accordance with the purchase selections made by the employee (Col. 16, lines 47-col. 17, line 39) (reads on benefit categories each being a subset of the benefit type)

Regarding the limitation of “the line items each being a subset of the benefit category” Warady discloses “simultaneously displaying a plurality of different line items associated with the benefit category (e.g. medical: Description of options A-M) to the employee on a user interface” (Fig. 7A-B).

Claim 108 has been further amended to recite: “identifying on said interface a predefined contribution, provided to said employee by an employer of said employee, for purchases associated with at least one of (i) the benefit type and (ii) at least one of the plurality of benefit categories” Wizig discloses identifying on a user interface a predefined contribution provided to said employee by an employer of said employee, for purchases *associated with at least one of* (i) the benefit type and (ii) at least one of the plurality of benefit categories. (Figure 24, 30, 53; Col. 12, lines 24-35: *An example of an employer confirmation page for the user "John Michael Jones", whose employer Wizig & Company contributes \$5,000.00 per year to his healthcare services package, is illustrated in FIG. 24.* Figure 54, col. 25, lines 5-12: *Generally, the sponsor report selection form allows the sponsor 130 to select a customized report based on either its plan members (e.g., by geographic area) or its aggregated or detailed contribution amounts (e.g., by month). The sponsor's report selection is received in step 844-* It should be noted any contribution of the employer for benefits is associated with at least one of: a benefit type or the plurality of benefit categories)

Wizig discloses a method wherein at least one of the different line items displayed on the interface includes a predefined employer contribution to said employee for purchase of said at least one of said line items. (col. 12, lines 24-29; Figure 30, 53),

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wherein said employee's employer provides said predefined contribution. (col. 12, lines 24-29; Figure 24)

Furthermore, it should be noted that these limitations regarding the data that are displayed on the screen, are not functionally involved in the steps recited. In particular, the steps recited in the claim would be performed the same regardless of the data contents of the noted material (i.e. the data displayed on the screen, simultaneously or otherwise). Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

7. Claims 1, 6-12, 15-17, 20, 40, 42-48, 51, and 109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wizig (USPN 6,735,569) in view of Warady et al. (US 6067522), and in further view of Decision Innovations (website packet)

[claim 1] Wizig discloses a method of providing benefits to an employee comprising:

- receiving an insurance coverage package selection from the employee wherein the insurance coverage package corresponds to a benefit type and automatically includes coverage under a plurality of benefit categories associated with the benefit type (e.g. insurance—benefit type); (Figure 55; col. 14, lines 38-64)
- for each of the plurality of benefit categories automatically included in the package receiving via the user interface an initial purchase selection from the employee

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corresponding to one of the plurality of different line items associated with the benefit category; and (Fig. 30, 33; col. 14, lines 38-64; Figure 55)

- providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in accordance with the purchase selections made by the employee (Col. 16, lines 47-col. 17, line 39)

Wizig discloses a method for customizing insurance coverage, as explained, but does not expressly disclose:

- displaying a plurality of different line items associated with the benefit category to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero.

Warady discloses

simultaneously displaying a plurality of different line items associated with the benefit category (e.g. medical: Description of options A-M) to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category (out of pocket cost— e.g.

deductible) and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category (cost for employee only, employee+children; employee+spouse; employee+spouse) and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero (Fig. 7A-B).

At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Wizig with the teaching of Warady to provide users with information on out-of-pocket costs as they are selecting a personalized healthcare plan. As suggested by Warady, one would have been motivated to include this feature to ensure that the employee is informed of and can easily enroll in the various plan options that match their needs. (col. 9, lines 49-col. 10, line 8)

Furthermore, it should be noted that these limitations regarding the data that are displayed on the screen, are nonfunctional description material and are not functionally involved in the steps recited. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Claim 1 has been amended to recite: "analyzing the initial purchase selection and making a suggestion of an offer for additional coverage based on the initial purchase selection..." and "providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in

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accordance with the initial purchase selections made by the employee and any additional purchase selections made based on the offer for additional coverage.”

Wizig and Warady in combination disclose allowing the user to select benefits packages, but do not expressly disclose “analyzing the initial purchase selection and making a suggestion of an offer for additional coverage based on the initial purchase selection and providing the insurance coverage package in accordance with the initial purchase selections made by the employee and any additional purchase selections made based on the offer for additional coverage.”

Decision Innovations discloses a system and method comprising “analyzing the initial purchase selection and making a suggestion of an offer for additional coverage based on the initial purchase selection (pg. 6, SmartChoice—selection of features and ranking features, asking for trade-offs, tells them which plan(s) best suit their needs) and providing the insurance coverage package in accordance with the initial purchase selections made by the employee and any additional purchase selections made based on the offer for additional coverage. (pg. 6, SmartChoice—matching users preferences to actual plans)

At the time of the applicant’s invention, it would have been obvious to one of ordinary skill in the art to modify the system and method Wizig and Warady in combination with the teachings of Decision Innovations. As suggested by Decision Innovations, one would have been motivated to include these features to allow the employee to bring together the best combination of benefits and find the benefits package which best fits their needs (pg. 6)

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[claims 6-7] Wizig teaches a method wherein said benefit costs to the employee for purchasing the coverage under the benefit category are established based on prior cost data or actuarial data. (col. 9, lines 50-67; col. 16, lines 47-col. 17, line 23; col. 20, lines 54-col. 21, line 50)

[claim 8] Wizig teaches a method further comprising: identifying a plurality of options for purchase by said employee within said line items. (Fig. 33)

[claim 9] Wizig teaches a method wherein said options comprise cost sharing options. (col. 8, lines 59-col. 9, line 19; Figure 33: sponsoring and co-payment)

[claim 10] Wizig teaches a method wherein said options comprise place of service options. (Figure 28: e.g. distance in miles/time from providers)

[claim 11] Wizig teaches a method wherein said options comprise benefit provider network options. (col. 13, lines 30-51; col. 15, lines 43-57)

[claim 12] Wizig teaches a method according to claim 8, said method further comprising: identifying a plurality of sub-options for purchase by said employee within said options. (Figures 30-31,55; col. 14, lines 38-64)

[claim 15] Wizig teaches a method wherein said computer network is a global computer network and wherein said user interface is provided at a web site on said network. (col. 6, lines 1-24)

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[claim 16] Wizig teaches a method further comprising: identifying factors on said user interface for said employee to consider in connection with the purchase of one or more of said line items. (Figures 26-29)

[claim 17] Wizig teaches a method according to claim 1, said method further comprising:

- querying said employee through said user interface for personal information related to said employee (Figure 20; Figure 28 e.g. preferences); and
- explaining the need for said personal information on said user interface. (Figure 28—explains how preference information is used)

[claim 20] Wizig teaches a method further comprising:

- creating data comprising personal information related to said employee and representing each said line item purchased by said employee; and (col. 10, lines 66-col. 11, line 8, lines 14-31; Figures 4A-4D, col. 13, lines 18-col. 14, line 25)
- transmitting said data to a customer service vendor configured to automatically build a customer benefit summary for said employee based on said data. (Figure 33, 55; col. 14, lines 38-64—e.g. Express Buy)

[claim 40] Wizig teaches a method of establishing a health care benefits offering to an employee group comprising:

- establishing a healthcare cost for said group; (Figures 4A-D, 32, col. 16, lines 19-47, e.g. family plans) and

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- establishing a plurality of health care line different items based on said cost. (Figures 31-32, col. 16, lines 19-47)
- said method further comprising:
- receiving an insurance coverage package selection from an employee in the group wherein the insurance coverage package corresponds to a benefit type and automatically includes coverage under a plurality of benefit categories associated with the benefit type (e.g. insurance—benefit type); (Figures 25, 37-38; 55; col. 14, lines 38-64)
- for each of the plurality of benefit categories automatically included in the package, receiving via the user interface an initial purchase selection from the employee corresponding to one of the plurality of different line items associated with the benefit category; and (Fig. 30, 33; col. 14, lines 38-64; Figure 55)
- providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in accordance with the purchase selections made by the employee (Col. 16, lines 47-col. 17, line 39)

Wizig discloses a method for customizing insurance coverage, as explained, but does not expressly disclose:

- displaying a plurality of different line items associated with the benefit category to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category and (ii) a corresponding benefit cost to

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the employee for purchasing the coverage under the benefit category and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero.

Warady discloses:

- simultaneously displaying a plurality of different line items associated with the benefit category (e.g. medical: Description of options A-M) to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category (out of pocket cost— e.g. deductible) and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category (cost for employee only, employee+children; employee+spouse; employee+spouse) and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero (Fig. 7A-B).

At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Wizig with the teaching of Warady to provide users with information on out-of-pocket costs as they are selecting a personalized healthcare plan. As suggested by Warady, one would have been motivated to include this feature to ensure that the employee is informed of and can easily enroll in the various plan options that match their needs. (col. 9, lines 49-col. 10, line 8)

Furthermore, it should be noted that these limitations regarding the data that are displayed on the screen, are nonfunctional description material and are not functionally involved in the steps recited. In particular, the steps recited in the claim would be performed the same regardless of the data contents of the noted material (i.e. the data displayed on the screen, simultaneously or otherwise). Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Claim 40 has been amended to recite: “analyzing the initial purchase selection and making a suggestion of an offer for additional coverage based on the initial purchase selection...” and “providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in accordance with the initial purchase selections made by the employee and any additional purchase selections made based on the offer for additional coverage.”

Wizig and Warady in combination disclose allowing the user to select benefits packages, but do not expressly disclose “analyzing the initial purchase selection and making a suggestion of an offer for additional coverage based on the initial purchase selection and providing the insurance coverage package in accordance with the initial purchase selections made by the employee and any additional purchase selections made based on the offer for additional coverage.”

Decision Innovations discloses a system and method comprising “analyzing the initial purchase selection and making a suggestion of an offer for additional coverage

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based on the initial purchase selection (pg. 6, SmartChoice—selection of features and ranking features, asking for trade-offs, tells them which plan(s) best suit their needs) and providing the insurance coverage package in accordance with the initial purchase selections made by the employee and any additional purchase selections made based on the offer for additional coverage. (pg. 6, SmartChoice—matching users preferences to actual plans)

At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system and method Wizig and Warady in combination with the teachings of Decision Innovations. As suggested by Decision Innovations, one would have been motivated to include these features to allow the employee to bring together the best combination of benefits and find the benefits package which best fits their needs (pg. 6)

[claims 42-43] Wizig teaches a method wherein healthcare costs are established based on prior cost data or actuarial data. (col. 9, lines 50-67; col. 16, lines 47-col. 17, line 23; col. 20, lines 54-col. 21, line 50)

[claim 44] Wizig teaches a method further comprising: establishing a plurality of options within at least one of said line items. (Fig. 33)

[claim 45] Wizig teaches a method wherein said options comprise cost sharing options. (col. 8, lines 59-col. 9, line 19; Figure 33: sponsoring and co-payment)

[claim 46] Wizig teaches a method wherein said options comprise place of service options. (Figure 28: e.g. distance in miles/time from providers)

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[claim 47] Wizig teaches a method wherein said options comprise benefit provider network options. (col. 13, lines 30-51; col. 15, lines 43-57)

[claim 48] Wizig teaches method further comprising: establishing a plurality of sub-options within at least one of said options. (Figures 30-31,55; col. 14, lines 38-64)

[claim 51] Wizig teaches a method wherein said computer network is a global computer network and wherein said user interface is provided at a web site on said network. (col. 6, lines 1-24)

[claim 109] Wizig teaches a system for providing benefits to an employee comprising:

- at least one database; (col. 7, line 47-56; Figures 1- 2)
- at least one processor for accessing said database; (Figs. 1-2; col. 6, line 62-col. 7, line 46) and
- a user-interface accessible through a computer network (col. 6, lines 15-24) for accessing said processor (Figures 1-2; 30-31; col. 6, lines 4-34)
- wherein the at least one processor receives an insurance coverage package selection from the employee wherein the insurance coverage package corresponds to a benefit type and automatically includes coverage under a plurality of benefit categories associated with the benefit type (e.g. insurance—benefit type); (Figure 55; col. 14, lines 38-64)
- wherein for each of the plurality of benefit categories automatically included in the package, the at least one processor receives via the user interface an initial purchase selection from the employee corresponding to one of the plurality of

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different line items associated with the benefit category; and (Fig. 30, 33; col. 14, lines 38-64; Figure 55)

- wherein the at least one processor is used for providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in accordance with the purchase selections made by the employee (Col. 16, lines 47-col. 17, line 39)

Wizig discloses a method for customizing insurance coverage, as explained, but does not expressly disclose:

- displaying a plurality of different line items associated with the benefit category to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero.

Warady discloses:

- simultaneously displaying a plurality of different line items associated with the benefit category (e.g. medical: Description of options A-M) to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost

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parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category (out of pocket cost— e.g. deductible) and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category (cost for employee only, employee+children; employee+spouse; employee+spouse) and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero (Fig. 7A-B).

At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Wizig with the teaching of Warady to provide users with information on out-of-pocket costs as they are selecting a personalized healthcare plan. As suggested by Warady, one would have been motivated to include this feature to ensure that the employee is informed of and can easily enroll in the various plan options that match their needs. (col. 9, lines 49-col. 10, line 8)

Claim 109 has been amended to recite: "analyzing the initial purchase selection and making a suggestion of an offer for additional coverage based on the initial purchase selection..." and "providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in accordance with the initial purchase selections made by the employee and any additional purchase selections made based on the offer for additional coverage."

Wizig and Warady in combination disclose allowing the user to select benefits packages, but do not expressly disclose "analyzing the initial purchase selection and

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making a suggestion of an offer for additional coverage based on the initial purchase selection and providing the insurance coverage package in accordance with the initial purchase selections made by the employee and any additional purchase selections made based on the offer for additional coverage.”

Decision Innovations discloses a system and method comprising: analyzing the initial purchase selection and making a suggestion of an offer for additional coverage based on the initial purchase selection (pg. 6, SmartChoice—selection of features and ranking features, asking for trade-offs, tells them which plan(s) best suit their needs) and providing the insurance coverage package in accordance with the initial purchase selections made by the employee and any additional purchase selections made based on the offer for additional coverage. (pg. 6, SmartChoice—matching users preferences to actual plans)

At the time of the applicant’s invention, it would have been obvious to one of ordinary skill in the art to modify the system and method Wizig and Warady in combination with the teachings of Decision Innovations. As suggested by Decision Innovations, one would have been motivated to include these features to allow the employee to bring together the best combination of benefits and find the benefits package which best fits their needs (pg. 6)

8. Claims 14,18-19, 50, and 106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wizig (USPN 6,735,569), Warady (US 6067522) and Decision Innovations, and in further view of Spurgeon (USPN 5,890,129)

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[claim 14] Wizig teaches a method and system for providing benefits to an individual (e.g. employee), and for providing a user interface for the selection of benefits over a computer network (col. 6, lines 15-24, Figures 1-2), but does not expressly disclose that the computer network is a local area network. Spurgeon discloses the use of local area networks (LAN's) to provide/transmit insurance benefits data (Figure 1; col. 6, lines 61-col. 7, line 7). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Wizig to include LAN's among the types of networks used to transmit/provide benefits data. As suggested by Spurgeon, one would have been motivated to include this feature to allow different parties (e.g. insurers/ healthcare providers) to continue to use their existing systems, while reaping the benefits of automatic exchange of insurance benefits information. (col. 2, lines 64-67)

[claims 18] Wizig teaches a method further comprising storing data representing each said line item purchased by said employee (Figures 9 and 15; col. 9, lines 6-19; col. 10, lines 16-31—databases store information on items purchased by employee). Wizig also teaches a method wherein profiles are created for the user, but does not expressly disclose transmitting the stored data to a benefit claims processing vendor configured to automatically build a benefit profile for said employee based on said data.

Spurgeon teaches a method wherein data gathered/stored from the user on selected benefits is transmitted to a benefit claims processing vendor (i.e. insurer or third party reviewer), which may build a profile of the individual (i.e. store a profile of the insured in a database). (Spurgeon: col. 4, lines 7-18; col. 6, lines 16-43). At the time of

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the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system/method of Wizig with the teaching of Spurgeon to provide user information to a benefit claims processor vendor (i.e. insurer/third party reviewer), which may provide a profile of the user. As suggested by Spurgeon, one would have been motivated to include this feature to increase the speed with which claims may be processed and paid (col. 4, lines 43-46) and to provide a mechanism for updating providers on the status of a patient/subscriber (i.e. the employee purchasing benefits). (col. 8, line 54-57)

[claim 19] Wizig and Spurgeon teach the method of providing benefits of claim 18 as explained in the rejection of 18. However, Wizig does not disclose claims processing and as such, does not disclose that the recited claims processing vendor is configured to confirm eligibility for payment of benefit claims based on the user's benefit profile. Spurgeon teaches a method and system wherein the benefit claims processing vendor (i.e. insurer or third party reviewer) is configured to confirm eligibility for payment of benefit claims based on the user's benefit profile. (col. 4, lines 7-18; col. 10, line 45-col. 11, line 10). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system/method of Wizig with the teaching of Spurgeon to have the claims processing vendor confirm status (i.e. eligibility) of the subscriber based upon the stored user information. As suggested by Spurgeon, one would have been motivated to include this feature to increase the speed with which claims may be processed and paid (col. 4, lines 43-46).

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[claim 50] Wizig teaches a method and system for providing benefits to an individual (e.g. employee), and for providing a user interface for the selection of benefits over a computer network (col. 6, lines 15-24, Figures 1-2), but does not expressly disclose that the computer network is a local area network. Spurgeon discloses the use of local area networks (LAN's) to provide/transmit insurance benefits data (Figure 1; col. 6, lines 61-col. 7, line 7). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Wizig to include LAN's among the types of networks used to transmit/provide benefits data. As suggested by Spurgeon, one would have been motivated to include this feature to allow different parties (e.g. insurers/ healthcare providers) to continue to use their existing systems, while reaping the benefits of automatic exchange of insurance benefits information. (col. 2, lines 64-67)

[claim 106] Wizig teaches a method of providing benefits to an employee comprising:

- receiving an insurance coverage package selection from the employee wherein the insurance coverage package corresponds to a benefit type and automatically includes coverage under a plurality of benefit categories associated with the benefit type (e.g. insurance—benefit type); (Figure 55; col. 14, lines 38-64)
- identifying a predefined employer contribution to said employee on said user interface for purchase of at least one of said line items. (col. 12, lines 24-29; Figure 24)

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- for each of the plurality of benefit categories automatically included in the package receiving via the user interface an initial purchase selection from the employee corresponding to one of the plurality of different line items associated with the benefit category; and (Fig. 30, 33; col. 14, lines 38-64; Figure 55)
- storing data representing each said line item purchased by said individual (Figures 9 and 15; col. 9, lines 6-19; col. 10, lines 16-31—databases store information on items purchased by employee)
- providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in accordance with the purchase selections made by the employee (Col. 16, lines 47-col. 17, line 39)

Wizig discloses a method for customizing insurance coverage, as explained, but does not expressly disclose:

- displaying a plurality of different line items associated with the benefit category to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero.

Warady discloses

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- simultaneously displaying a plurality of different line items associated with the benefit category (e.g. medical: Description of options A-M) to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category (out of pocket cost— e.g. deductible) and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category (cost for employee only, employee+children; employee+spouse; employee+spouse) and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero (Fig. 7A-B).

At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Wizig with the teaching of Warady to provide users with information on out-of-pocket costs as they are selecting a personalized healthcare plan. As suggested by Warady, one would have been motivated to include this feature to ensure that the employee is informed of and can easily enroll in the various plan options that match their needs. (col. 9, lines 49-col. 10, line 8)

Furthermore, it should be noted that these limitations regarding the data that are displayed on the screen, and are not functionally involved in the steps recited, and do not structurally alter the hardware used to carry out the steps. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of

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patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Claim 106 has been amended to recite: “analyzing the initial purchase selection and making a suggestion of an offer for additional coverage based on the initial purchase selection...” and “providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in accordance with the initial purchase selections made by the employee and any additional purchase selections made based on the offer for additional coverage.”

Wizig and Warady in combination disclose allowing the user to select benefits packages, but do not expressly disclose “analyzing the initial purchase selection and making a suggestion of an offer for additional coverage based on the initial purchase selection and providing the insurance coverage package in accordance with the initial purchase selections made by the employee and any additional purchase selections made based on the offer for additional coverage.”

Decision Innovations discloses a system and method comprising: analyzing the initial purchase selection and making a suggestion of an offer for additional coverage based on the initial purchase selection (pg. 6, SmartChoice—selection of features and ranking features, asking for trade-offs, tells them which plan(s) best suit their needs) and providing the insurance coverage package in accordance with the initial purchase selections made by the employee and any additional purchase selections made based on the offer for additional coverage. (pg. 6, SmartChoice—matching users preferences to actual plans)

At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system and method Wizig and Warady in combination with the teachings of Decision Innovations. As suggested by Decision Innovations, one would have been motivated to include these features to allow the employee to bring together the best combination of benefits and find the benefits package which best fits their needs (pg. 6)

Wizig also teaches a method wherein profiles are created for the user, but does not expressly disclose transmitting the stored data to a benefit claims processing vendor configured to automatically build a benefit profile for said employee based on said data.

Spurgeon teaches a method wherein data gathered/stored from the user on selected benefits is transmitted to a benefit claims processing vendor (i.e. insurer or third party reviewer), which may build a profile of the individual (i.e. store a profile of the insured in a database). (Spurgeon: col. 4, lines 7-18; col. 6, lines 16-43). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system/method of Wizig, Warady and Decision Innovations with the teaching of Spurgeon to provide user information to a benefit claims processor vendor (i.e. insurer/third party reviewer), which may provide a profile of the user. As suggested by Spurgeon, one would have been motivated to include this feature to increase the speed with which claims may be processed and paid (col. 4, lines 43-46) and to provide a mechanism for updating providers on the status of a patient/subscriber (i.e. the employee purchasing benefits). (col. 8, line 54-57).

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9. Claim 33,37-38,81, and 110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wzig (USPN 6,735,569), and Warady (US 6067522) and in view of Spurgeon (USPN 5,890,129).

[claim 33] Wzig teaches a method and system for providing benefits to an individual (e.g. employee), and for providing a user interface for the selection of benefits over a computer network (col. 6, lines 15-24, Figures 1-2), but does not expressly disclose that the computer network is a local area network. Spurgeon discloses the use of local area networks (LAN's) to provide/transmit insurance benefits data (Figure 1; col. 6, lines 61-col. 7, line 7). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Wzig to include LAN's among the types of networks used to transmit/provide benefits data. As suggested by Spurgeon, one would have been motivated to include this feature to allow different parties (e.g. insurers/ healthcare providers) to continue to use their existing systems, while reaping the benefits of automatic exchange of insurance benefits information. (col. 2, lines 64-67)

[claims 37] Wzig teaches a method further comprising storing data representing each said line item purchased by said employee (Figures 9 and 15; col. 9, lines 6-19; col. 10, lines 16-31—databases store information on items purchased by employee). Wzig also teaches a method wherein profiles are created for the user, but does not expressly disclose transmitting the stored data to a benefit claims processing vendor configured to automatically build a benefit profile for said employee based on said data.

Spurgeon teaches a method wherein data gathered/stored from the user on selected benefits is transmitted to a benefit claims processing vendor (i.e. insurer or third party reviewer), which may build a profile of the individual (i.e. store a profile of the insured in a database). (Spurgeon: col. 4, lines 7-18; col. 6, lines 16-43). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system/method of Wizig with the teaching of Spurgeon to provide user information to a benefit claims processor vendor (i.e. insurer/third party reviewer), which may provide a profile of the user. As suggested by Spurgeon, one would have been motivated to include this feature to increase the speed with which claims may be processed and paid (col. 4, lines 43-46) and to provide a mechanism for updating providers on the status of a patient/subscriber (i.e. the employee purchasing benefits). (col. 8, line 54-57)

[claim 38] Wizig, Warady and Spurgeon teach the method of providing benefits as explained in the rejection of 37. However, Wizig does not disclose claims processing and as such, does not disclose that the recited claims processing vendor is configured to confirm eligibility for payment of benefit claims based on the user's benefit profile. Spurgeon teaches a method and system wherein the benefit claims processing vendor (i.e. insurer or third party reviewer) is configured to confirm eligibility for payment of benefit claims based on the user's benefit profile. (col. 4, lines 7-18; col. 10, line 45-col. 11, line 10). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system/method of Wizig with the teaching of Spurgeon to have the claims processing vendor confirm status (i.e. eligibility) of the

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subscriber based upon the stored user information. As suggested by Spurgeon, one would have been motivated to include this feature to increase the speed with which claims may be processed and paid (col. 4, lines 43-46).

[claim 81] Wizig teaches a method and system for providing benefits to an individual (e.g. employee), and for providing a user interface for the selection of benefits over a computer network (col. 6, lines 15-24, Figures 1-2), but does not expressly disclose that the computer network is a local area network. Spurgeon discloses the use of local area networks (LAN's) to provide/transmit insurance benefits data (Figure 1; col. 6, lines 61-col. 7, line 7). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Wizig to include LAN's among the types of networks used to transmit/provide benefits data. As suggested by Spurgeon, one would have been motivated to include this feature to allow different parties (e.g. insurers/ healthcare providers) to continue to use their existing systems, while reaping the benefits of automatic exchange of insurance benefits information. (col. 2, lines 64-67)

[claim 110] Wizig teaches a method of providing benefits to an employee comprising:

- receiving an insurance coverage package selection from the employee wherein the insurance coverage package corresponds to a benefit type and automatically includes coverage under a plurality of benefit categories associated with the benefit type (e.g. insurance—benefit type); (Figure 55; col. 14, lines 38-64)

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- identifying a predefined employer contribution to said employee on said user interface for purchase of at least one of said line items. (col. 12, lines 24-29; Figure 24)
- for each of the plurality of benefit categories automatically included in the package receiving via the user interface a purchase selection from the employee corresponding to one of the plurality of different line items associated with the benefit category; and (Fig. 30, 33; col. 14, lines 38-64; Figure 55)
- storing data representing each said line item purchased by said individual (Figures 9 and 15; col. 9, lines 6-19; col. 10, lines 16-31—databases store information on items purchased by employee)
- providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in accordance with the purchase selections made by the employee (Col. 16, lines 47-col. 17, line 39)

Wizig discloses a method for customizing insurance coverage, as explained, but does not expressly disclose:

- simultaneously displaying a plurality of different line items associated with the benefit category to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category and wherein the benefit cost

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presented to the employee for at least one of the different line items associated with the benefit category is non-zero.

Warady discloses

- simultaneously displaying a plurality of different line items associated with the benefit category (e.g. medical: Description of options A-M) to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category (out of pocket cost— e.g. deductible) and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category (cost for employee only, employee+children; employee+spouse; employee+spouse) and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero (Fig. 7A-B).

At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Wizig with the teaching of Warady to provide users with information on out-of-pocket costs as they are selecting a personalized healthcare plan. As suggested by Warady, one would have been motivated to include this feature to ensure that the employee is informed of and can easily enroll in the various plan options that match their needs. (col. 9, lines 49-col. 10, line 8)

Claim 110 has been amended to recite: “the benefit categories each being a subset of the benefit type...” (See rejection under 35 USC 112, 1<sup>st</sup> para.), and “the line items each being a subset of the benefit category.”

Wizig discloses providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in accordance with the purchase selections made by the employee (Col. 16, lines 47-col. 17, line 39) (reads on benefit categories each being a subset of the benefit type)

Regarding the limitation of “the line items each being a subset of the benefit category” Warady discloses “simultaneously displaying a plurality of different line items associated with the benefit category (e.g. medical: Description of options A-M) to the employee on a user interface” (Fig. 7A-B).

Claim 110 has been further amended to recite: “identifying on said interface a predefined contribution, provided to said employee by an employer of said employee, for purchases associated with at least one of (i) the benefit type and (ii) at least one of the plurality of benefit categories” Wizig discloses identifying on a user interface a predefined contribution provided to said employee by an employer of said employee, for purchases *associated with at least one of* (i) the benefit type and (ii) at least one of the plurality of benefit categories. (Figure 24, 30, 53; Col. 12, lines 24-35: *An example of an employer confirmation page for the user "John Michael Jones", whose employer Wizig & Company contributes \$5,000.00 per year to his healthcare services package, is illustrated in FIG. 24.* Figure 54, col. 25, lines 5-12: *Generally, the sponsor report selection form allows the sponsor 130 to select a customized report based on either its*

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*plan members (e.g., by geographic area) or its aggregated or detailed contribution amounts (e.g., by month). The sponsor's report selection is received in step 844- It should be noted any contribution of the employer for benefits is associated with at least one of: a benefit type or the plurality of benefit categories)*

Wizig discloses a method wherein at least one of the different line items displayed on the interface includes a predefined employer contribution to said employee for purchase of said at least one of said line items. (col. 12, lines 24-29; Figure 30, 53), wherein said employee's employer provides said predefined contribution. (col. 12, lines 24-29; Figure 24)

Furthermore, it should be noted that these limitations regarding the data that are displayed on the screen, are nonfunctional description material and are not functionally involved in the steps recited. In particular, the steps recited in the claim would be performed the same regardless of the data contents of the noted material (i.e. the data displayed on the screen, simultaneously or otherwise). Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Wizig also teaches a method wherein profiles are created for the user, but does not expressly disclose transmitting the stored data to a benefit claims processing vendor configured to automatically build a benefit profile for said employee based on said data.

Spurgeon teaches a method wherein data gathered/stored from the user on selected benefits is transmitted to a benefit claims processing vendor (i.e. insurer or

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third party reviewer), which may build a profile of the individual (i.e. store a profile of the insured in a database). (Spurgeon: col. 4, lines 7-18; col. 6, lines 16-43). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system/method of Wizig and Warady in combination with the teaching of Spurgeon to provide user information to a benefit claims processor vendor (i.e. insurer/third party reviewer), which may provide a profile of the user. As suggested by Spurgeon, one would have been motivated to include this feature to increase the speed with which claims may be processed and paid (col. 4, lines 43-46) and to provide a mechanism for updating providers on the status of a patient/subscriber (i.e. the employee purchasing benefits). (col. 8, line 54-57)

### ***Response to Arguments***

10. Applicant's arguments filed 9/12/12 have been fully considered but they are not persuasive.

(A) Applicant argues that the prior art does not disclose the limitation of: benefit categories each being a subset of the benefit type.

In response, the amendment has been addressed with additional citations from the references, as well as under 35 USC 112, 1st paragraph. It is noted that the originally filed disclosure does not provide a description of the nested or hierarchical relationship between these terms as explained in the rejection.

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(B) Applicant argues that the prior art does not teach the newly added feature(s) of "analyzing the initial purchase selection and making a suggestion of an offer for additional coverage based on the initial purchase selection."

These newly added limitations have been addressed with an additional reference/ new grounds of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHEL L. PORTER whose telephone number is (571)272-6775. The examiner can normally be reached on M-F, 10-6:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Morgan can be reached on (571) 272-6773. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L. P./  
Examiner, Art Unit 3626

/Robert Morgan/  
Supervisory Patent Examiner, Art Unit 3626